

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Tadros et al.	
Application No.: 09/682,749	
Filed: 10/12/2001	Group Art Unit: 1711
Title: Multilayer, Weatherable Compositions And Method of Manufacture Thereof	Examiner: M. Bissett
Attorney Docket No.: GEPL.P-068	Confirmation No.: 8016

REPLY BRIEF FOR APPELLANT

This Reply Brief is filed in support of Applicants' Appeal from the final rejection mailed 7/14/2005, in view of the Examiner's Answer mailed April 6, 2006.

In Appellants' Brief, three separate lines of arguments were presented: (1) whether there is in fact a *prima facie* case of obviousness presented based on the cited references, (2) the scope of evidence that is necessary to establish unexpected results and whether this scope has been submitted, and (3) the sufficiency of the evidence presented in the context of individual claims 24 and 25. Regrettably, the substance of the Examiner's Answer is little more than a reprinting of the office action, and fails to respond directly to Applicants' arguments specific to these issues.

There is no case of prima facie obviousness

The Examiner has not identified a suggestion in the art for changing the upper layer as disclosed in MacGregor that comprises the materials recited in the claims, plus other materials, into an upper that consists essentially of the recited materials. Indeed, at Page 7 of the Examiner's Answer the argument is made that the "the reference does teach a cap layer comprising these three chemical components." Applicants never argued that it did not. Applicants argued that it does not teach or suggest a layer *consisting essentially* of the recited components, and the Examiner has still not explained how it does.

Further, although the argument is repeated (Examiner's Answer, Pages 4 and 7), the Examiner has not explained the relevance of the obviousness of applying "more than one layer of cycloaliphatic polyester composition to amplify the weatherability properties of the film" to the

claimed invention which is not broadly directed to a layered composition with multiple layers of cycloaliphatic polyester. The claims are specifically directed to a composition with two distinct layers with defined compositions that include cycloaliphatic polyester, and the Examiner has not said why the claimed selection of different layers and the claimed selection of materials for these layers would have been suggested by the reference. A general assertion of obviousness of a broad genus is not sufficient to create a *prima facie* case of obviousness for more specific subject matter. That is all that the Examiner has provided here.

The evidence of record establishes unexpected results

The Examiner has again stated that the evidence of record does not establish results because it is not commensurate in scope with the claims. Specifically, the Examiner has said that Applicants' examples are not deemed representative, but has still not said why. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (POBAI 1986) holds that before an Applicant can be required to assume the burden of testing multiple allegedly anticipatory compounds, "the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." It stands to reason that the Examiner must also provide some basis for the assertion that the compounds tested are not representative of the claimed genus, so that an Applicant can either respond to the argument on its merits or test appropriate additional examples without having to guess at the Examiner's thought process.

The Examiner also argues on Page 8 of the Examiner's answer that "no thicknesses, amounts of materials or process specification are given to show that the results are in fact dependent on the variable in question." The Examiner has not indicated why this argument is maintained in light of the third declaration under 37 CFR § 132, in which the use of the same materials and the same thicknesses in each cases was attested to.

The evidence of record establishes unexpected results for claims 24 and 25

The Examiner has not specifically addressed the arguments made with respect to claims 24 and 25. As previously noted, the argument concerning the testing of other polyesters is not relevant since claim 24 specifically recites PCCD as the cycloaliphatic polyester and this is the polyester that was tested. Thus, the only apparent objection that could possibly be raised with respect to the sufficiency of the evidence with respect to this claim and claim 25 which is dependent on claim 24, is the belated assertion that testing without TiO₂, and possibly with other pigments also needs to be done. This argument is not repeated in the Examiner's Answer and therefore presumably has been withdrawn.

Respectfully submitted,



Marina T. Larson Ph.D.
PTO Reg. No. 32,038
Attorney for Applicant
(970) 262-1800